

REMARKS

Claims 1-38 are pending in the application and stand rejected.

Rejection under 35 U.S.C §101

Claims 1-38 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. In particular, the Examiner finds that, with regard to claim 1, such claim is an apparatus claim directed toward non-statutory subject matter insofar as it discloses software limitations. Applicants respectfully disagree and assert that the Examiner is improperly categorizing the subject matter of the claims and failing to apply the proper test for determining patentability.

I. The claims are patentable subject matter under 35 U.S.C. §101 because their subject matter satisfies the current USPTO definition of patentable subject matter

To begin with, the subject matter of claim 1 is not directed towards software per se. Rather, it is an “apparatus for accessing data from a database.” Additionally, Claim 1 recites “a client computer,” “one or more database proxy objects,” “a database,” and “a server computer.” Therefore, Applicants respectfully traverse the Examiner’s characterization of the subject matter of in claim 1 as software per se. Similarly, the other independent claims, claims 11, 20, 29 and 30, are not directed towards software per se. Claim 11 recites “a client computer,” “an application server,” “a database,” “an application server,” and “proxy objects.” Claim 20 recites “one or more database proxy objects,” “an application server,” “drivers,” and “database.” Claim 29 recites “a database,” “one or more database proxy objects,” and “an application server.” Finally, Claim 30 recites “a database,” “one or more database proxy objects,” and “an application server”

Further, it appears that the test for determining patentable subject matter applied by the Examiner is an outdated. According to the USPTO’s 2005 publication entitled “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” page 42, Examiners are forbidden to apply outdated tests, including the “machine implemented” test and the “per se data transformation” test. The following is the

internet link to this publication:

http://www.uspto.gov/web/offices/pac/dapp/ropa/preognitice/guidelines101_20051026.pdf

The currently applied test is set forth in § 2106 of the MPEP. According to § 2106 IV.C., patentable subject matter encompasses not only “subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter)” but also subject matter covered by either “a 35 U.S.C. 101 judicial exception or a practical application of a 35 U.S.C. 101 judicial exception.” A practical application of a judicial exception can be shown be either a **physical transformation or the production of a useful, concrete and tangible result**. MPEP 2106 IV.C.2 (emphasis added).

A. The Claims are Directed Towards a Physical Transformation

If a claim provides for a transformation or reduction of an article to a different state or thing, then the claim meets the statutory requirement of 35 U.S.C. § 101. MPEP 2106 IV.C.2(1). Claim 1’s “...one or more proxy objects being generated in response to commands from the first application...generating a database query based on the proxy objects and the drivers and returning the database query results to the first application” provides for transformation of data from one form to another. The commands from the first application are transformed into proxy objects, and information from the proxy objects and drivers is transformed into a database query. These transformations of data represent a practical application by physical transformation. According to MPEP 2106 IV.C.2(1), “[i]f USPTO personnel find such a transformation or reduction, USPTO personnel shall end the inquiry and find that the claim meets the statutory requirements of 35 U.S.C. 101.

Similar to Claim 1, independent claims 11, 20, 29 and 30 are directed toward a physical transformation. Claim 11’s “...executing a first application on a client computer that generates one or more proxy objects...” and “generating one or more database requests at the application server based on the proxy objects, the database requests being generating using database drivers...” provides for transformation of data from one form “information from a first application” to another “one or more proxy objects” and in turn to yet another—the data base proxy objects being generated from data from the proxy objects and the database drivers. Similar to claim 1’s transformation of data are transformations embodied in claims 20, 29 and 30. Claim 20 provides “...generating one or more database proxy objects in response to a database request...” and “...means...to generate one or more database requests based on the

database proxy objects,..." Also, claim 29 provides "...one or more database proxy objects that are generated by the Java applet in response to a database request..." and "...generates one or more objects corresponding to the database proxy objects." Further, claim 30 provides for a transformation of data from a first application to database proxy objects and from database proxy objects a second application.

B. The Claims are Directed Toward The Production of a Useful, Concrete, and Tangible Result

"If USPTO personnel do not find such a transformation or reduction, they must determine whether the claimed invention produces a useful, concrete, and tangible result." MPEP 2106 IV.C.2(1). In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete."" MPEP 2106 IV.C.2 (emphasis added).

1. The Inventions Claimed Are Useful Because They Are Specific, Substantial and Credible

For an invention to be "useful" its utility must be (i) specific, (ii) substantial and (iii) credible. *Id.* (*citing MPEP § 2107 and Fisher, 421 F.3d at 1372, 76 USPQ2d at 1230 (citation omitted)).*

(a). The Claims Embody Specific Elements

Applicants respectfully submit that Claim 1, in its current form, recites "specific" elements: "[a]n apparatus for accessing data from a database ... comprising ... a first application ... proxy objects requesting data from a database ... one or more drivers ... and a second application ... generating a database query based on the proxy objects and the drivers and returning the database query to the first application" (emphasis added). However, the utility of a claim under 35 U.S.C. § 101 must be assessed looking at the claim as a whole. *MPEP 2106 II.C* (*citing Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)*)).

Likewise, independent Claims 11, 20, 29 and 30 embody specific elements. Claim 11, in its current form, recites specific elements: "[a] method for accessing data located behind a security mechanism, comprising...a first application...one or more proxy objects...a second

application...an application server...database requests...database drivers...a database...client computer...” Claim 20, in its current form, recites specific elements: “[a] system for accessing data located behind a security mechanism, comprising...means for generating one or more database proxy objects...an application server...means for processing the received database proxy objects...means for using one or more drivers to generate one or more database requests based on the proxy objects...database.”

Claim 29, in its current form, recites specific elements: “[a] system for accessing data by a Java applet wherein the data is located behind a security mechanism, the system comprising...a client...a Java applet...a database...database proxy objects...an application server...a servlet...one or more JDBC drivers...” Claim 30, in its current form, recited specific elements: “[a] system for accessing data located behind a security mechanism, comprising...a client...a first application...a database...one or more database proxy objects...an application server...one or more second applications...one or more corresponding objects...one or more drivers that interface with a database.”

(b). The Claims Embody Substantial and Credible Elements

Applicants further submit that the “substantial” and “credible” nature of the invention of claim 1 is demonstrated by its novel features, including: (1) “*requesting data from a database*” of the proxy objects; (2) “*generating a database query*”; (3) “*returning the database query to the first application*” of the second application; (4) “*a second application capable of being executed on a server computer separated from the first application by a security mechanism...and returning the results to the first application*”; and (5) “*generating a database query based on the proxy objects and the drivers.*” Novel features are similarly found in the other independent claims, claims 11, 20, 29 and 30. Many of these features are underlined in the above analysis directed towards proving that the elements of these claims are specific.

2. The Inventions Claimed Are Concrete Because They Are Substantially Repeatable

Finally, to satisfy the “concrete result” prong, the invention must have a result that can be substantially repeatable or the process must substantially produce the same result again versus being unrepeatable and unpredictable. *MPEP IV. C.2(2)(b)(citing In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)).* “Resolving this question is dependent on the

level of skill in the art" and involves the issue of enablement of the invention. *Id.* The claims read in light of the specification enable one skilled in the art to make and use the claimed invention without undue experimentation. This conclusion is supported by the Examiner's failure to object to the enablement of the claims.

3. The Inventions Claimed Are Tangible Because They Produce A Real-World Result

In order to satisfy the "tangible result" prong, the claimed invention neither need be tied to a particular machine or apparatus, nor must operate to change articles or materials to a different state or thing. *MPEP IV. C.2(2)(b).* Instead the claimed invention merely needs "to produce a real-world result." *Id.* One of the real-world results of the claimed invention, as disclosed in the specification, page 3, lines 19-24, comprises: "*secure data accessing system and method...overcomes the limitations associated with the typical systems. The secure data accessing system...useful for a distributed/computing environment...extensive access to a variety of database servers...communication by tunneling through a security mechanism...*"

Rejection under 35 U.S.C §112

Claims 1-38 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, which is analogously based on the 35 U.S.C. 101. For the reasons discussed above regarding overcoming the 101 rejection, Applicants respectfully traverse the 112 rejection.

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

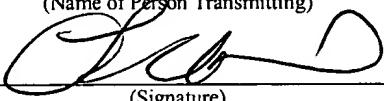
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Respectfully submitted,



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